

### REMARKS

The Amendment is submitted in response to the Office Action dated December 29, 2003. In the Office Action, the Patent Office rejected Claims 1-7 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention; and rejected Claims 1-7 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. In addition, the Patent Office rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 4 of U.S. Patent. No. 6,089,613 to *Petkovsek* in view of PAP US 2002/0103697 to *Lockhart et al.*; Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.* (5,782,494); and Claims 3-7 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.* in view of *Petkovsek*.

By the present amendment, Applicant amended Claim 1. Applicant asserts that the application is in condition for allowance in view of the amendment to Claim 1 and for the reasons that follow. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1-7

under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Patent Office alleges that:

"Claim 1 discloses 'a first layer... wherein a first part receives a first type of electronically-imaged postage accessed over a global computer network and further wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network wherein the first type of electronically-imaged postage is different from the second type of electronically-imaged postage...', wherein the form has a combination of a first type of postage and a second type of postage."

The Patent Office further alleges that the text of Claim 1 is different from what the specification discloses at page 6, lines 5-10, and page 8, lines 19-23.

However, Claim 1, as amended, requires a form having a first part and a second part wherein the first part is sized to correspond to a first type of postage and the second part is sized to correspond to a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage. In addition, Claim 1, as amended, requires that one of the first type of

electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service. Applicant asserts that by amending the claim to require either the first type of postage or the second type of postage to effect delivery, Claim 1 defines subject matter disclosed in the specification. Accordingly, the rejection of Claim 1 under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn. Notice to that effect is requested.

The Patent Office rejected Claims 1-7 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. The Patent Office alleges that "it is not understood how 'the first type of electronically-imaged postage is different from the second type of electronically-imaged postage'".

However, on page 6, line 19 of the specification, Applicant discloses that a user may have a particular account with an internet provider, and the postage may be paid for upon downloading of the postage. Further, Applicant discloses that:

"The first stamp subsection 14 and the second stamp subsection 16 may be sized to receive only certain types of postage from a particular internet postage provider. A user may be able to use the form 1 if the internet postage provider with which the user has an account provides electronic postage sized to fit within the first stamp subsection 14 or the second stamp subsection 16. Of course, the form 1 may be adapted to fit other sizes of electronic postage and/or additional sizes of

electronic postage."

Claim 1, as amended, defines a first part which is sized to correspond to a first type of electronically-imaged postage and a second part sized to correspond to a second type of electronically-imaged postage. Moreover, Claim 1, as amended requires that the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage. Thus, Claim 1, as amended, defines how the first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Accordingly, Claims 1-7 particularly point out and distinctly claim the subject matter. Therefore, the rejection of Claims 1-7 under 35 U.S.C. §112, second paragraph, is improper and should be withdrawn. Notice to that effect is requested.

The Patent Office rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 4 of U.S. Patent. No. 6,089,613 to *Petkovsek* in view of PAP US 2002/0103697 to *Lockhart et al.*

However, Claim 1, as amended, requires a first layer having a front side and a back side wherein the front side of the first layer has a plurality of parts. A first part is sized to correspond to a first type of electronically-imaged postage

accessed over a global computer network. A second part is sized to correspond to a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage. Additionally, one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service.

The Examiner admits that *Petkovsek* does not disclose a first part which receives electronically-imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece and a second part which receives electronically-imaged postage accessed over a global computer network necessary to effect delivery of a mailpiece. The Examiner alleges *Lockhart et al.* disclose a form having electronically-imaged postage accessed over a global computer network.

However, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service having a first part which is sized to correspond to a first type of electronically-imaged postage accessed over a global computer network and having a second part which is sized to correspond to a second type of electronically-

imaged postage accessed over a global computer network as required by Claim 1. Further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage, as required by Claim 1. Still further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service wherein one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service as required by amended Claim 1.

Rather, the form taught by *Petkovsek* merely has a plurality of parts which receive special service mail information, sender information and recipient information. None of the plurality of parts receive electronically-imaged postage. Further, the system in *Lockhart et al.* is a distribution system for generating and delivering mail items which receives a postage marking. *Lockhart et al.* do not teach or suggest a form which is capable of receiving a plurality of types of electronically-imaged postage wherein the types of electronically-imaged postage are accessed

from a first provider of electronically-imaged postage or a second provider of electronically-imaged postage. Accordingly, a person of ordinary skill in the art would never have been motivated to modify the teachings of *Petkovsek*, which does not teach the use of electronically-imaged postage, with *Lockhart et al.* to achieve that defined by Claim 1 of the present invention.

With respect to the Examiner's allegation that the limitation "wherein the electronically-imaged information is necessary to effect the delivery of the mailpiece" does not structurally limit the claim, Applicant submits that the electronically-imaged information is necessary to effect the delivery of the mailpiece by the special service and, therefore, structurally limits the claim. More specifically, the present invention, as defined by amended Claim 1, specifically sets forth a form for delivery of a mailpiece by a special service that requires one of a first type of electronically-imaged postage or a second type of electronically-imaged postage to effect the delivery of the mailpiece by the special service. Applicant asserts that a functional relationship between the electronically-imaged postage and the form is inherent in that the postage is required on the form to effect delivery of the form via the special service.

*Petkovsek* and *Lockhart et al.* relate only to a label/form for receiving and displaying of information relating to shipment

and handling of an article for delivery by a special service and a generating system for generating and delivering mail items having an electronically-imaged postage mark accessed over a global computer network. Absolutely no teaching or suggestion is provided for a label/form and generating system wherein a first part is sized to correspond to a first type of electronically-imaged postage and a second part is sized to correspond to a second type of electronically-imaged postage. One of the first type of postage or the second type of postage is necessary to effect the delivery of a mailpiece by the special service as required by amended Claim 1. Moreover, a form having a first part sized to correspond to a first electronically-imaged postage and a second part sized to correspond to a second type of electronically-imaged postage, with either type of postage necessary to effect the delivery of a mailpiece by the special service, is essential to the present invention and structurally limits Claim 1.

An obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001).



A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998).

Neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service wherein a first type of electronically-imaged postage or a second type of electronically-imaged postage are necessary to effect the delivery of the mailpiece by the special service and further wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of

electronically-imaged postage is accessible from a second provider of electronically-imaged postage. Furthermore, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Petkovsek* with *Lockhart et al.* in the manner suggested by the Examiner in formulating the rejection under the judicially created doctrine of obviousness-type double patenting. Accordingly, the rejection of Claims 1-7 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.* (5,782,494).

However, Claim 1, as amended, requires a form having a first part which is sized to correspond to a first type of electronically-imaged postage accessed over a global computer network and a second part which is sized to correspond to a second type of electronically-imaged postage accessed over a global computer network. By admission of the Examiner, *Crandall et al.* do not disclose the plurality of parts which receive electronically-imaged postage accessed over a global computer network wherein the electronically-imaged information is necessary to effect the delivery of the mailpiece. Moreover, Applicant asserts that no teaching or suggestion is provided in *Crandall et al.* for accessing electronically-imaged postage over

a global computer network. *Crandall et al.* merely teach a template stored on a personal computer. No teaching or suggestion exists in *Crandall et al.* for accessing information from a location remote from the personal computer, such as over a global computer network. Accordingly, a person of ordinary skill in the art would not have been motivated to modify *Crandall et al.* to achieve that defined by Claims 1 and 2 of the present invention.

Further, the Examiner alleges that Claim 1 is unpatentable for allegedly having an insufficient functional relationship between indicia and substrate. However, as set forth above, Claim 1 requires a form having a first part which is sized to correspond to a first type of electronically-imaged postage accessed over a global computer network and a second part which is sized to correspond to a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage. Therefore, Applicant submits that a functional relationship exists, namely, the size of the first part and second part in relation to the electronically-imaged postage.

Claim 2 defines the form as further having a second layer

having a front side with a non-adhesive layer wherein each of the plurality of parts is removably secured to the non-adhesive layer.

Nowhere do *Crandall et al.* teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein a first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and a second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and further wherein the form also has a second layer having a front side with a non-adhesive layer wherein each of the plurality of parts is removably secured to the non-adhesive layer. Therefore, Claim 2 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention in view of *Crandall et al.* Accordingly, the rejection under 35 U.S.C. §103(a) in view of *Crandall et al.* is improper.

Moreover, a person of ordinary skill in the art would never have been motivated to modify the teaching of *Crandall et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461

F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have modified *Crandall et al.* as set forth by the Examiner, the resultant modification still lacks the critical features and structural relationships positively recited in Claims 1 and 2. Therefore, the rejection of Claims 1 and 2 under 35 U.S.C §103(a) is improper and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 3-7 under 35 U.S.C §103(a) as being unpatentable over *Crandall et al.* in view of *Petkovsek*.

However, Claim 3 requires a form having all of the features of amended Claim 1 wherein one of the plurality of parts of the form receives special service mail information. Nowhere do *Crandall et al.* and *Petkovsek* teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and wherein the form also contains a part which receives special service mail information. Therefore, Claim 3 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention in view of *Crandall et al.* and *Petkovsek*.

Claim 4 requires a postcard subsection. Nowhere do *Crandall et al.* or *Petkovsek* teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and wherein the form also has a postcard subsection.

Claim 5 requires a special mailing service section that

receives special mailing service information. Nowhere do *Crandall et al.* and *Petkovsek* teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and wherein the form also has a special mailing service section that receives special mailing service information.

Claim 6 requires that one of the plurality of parts receive sender information. Nowhere do *Crandall et al.* and *Petkovsek* teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and wherein one of the plurality of parts receives sender information. Therefore, Claim 6 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention in view of *Crandall et al.* and *Petkovsek*.

Claim 7 requires that one of the plurality of parts receives recipient information. Nowhere do *Crandall et al.* and *Petkovsek*

teach or suggest a form having a plurality of parts sized to correspond to a first type of postage or a second type of postage wherein the first type of electronically-imaged postage is accessible from a first provider of electronically-imaged postage and the second type of electronically-imaged postage is accessible from a second provider of electronically-imaged postage and wherein one of the plurality of parts receives recipient information. Therefore, Claim 7 would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention in view of *Crandall et al.* and *Petkovsek*.

Moreover, a person of ordinary skill in the art would never have been motivated to combine *Crandall et al.* with *Petkovsek* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the reference in its entirety, would have been obvious to one of ordinary skill



in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have combined *Crandall et al.* with *Petkovsek* as set forth by the Examiner, the resultant combination still lacks the critical features and structural relationships positively recited in Claims 3-7. Therefore, the rejection of Claims 3-7 under 35 U.S.C. §103(a) is improper.

Claims 2-7 depend from Claim 1. These claims are also believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements of Applicant's form for delivery of a mailpiece by a special service. Notice to that effect is requested.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application



expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 12, 2004.

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